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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,837	01/15/2004	Matthias Konrad	03/004 MFE	5083
38263	7590	09/16/2005	EXAMINER	
PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			TRAN, THAO T	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 09/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,837

Applicant(s)

KONRAD ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-12, 14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12, 14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/2005 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 7-12, 14, 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 contains the newly added limitation, "said overlayer (A) forming an outermost layer of said film" that has no support in the application as originally presented. The specification, paragraph crossing pages 7 and 8, states, "The film of the present invention has an at least two-layer structure. In that case it consists of the inventive base layer (B) and the

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inventive overlayer (A) disposed on it. In addition, the films may contain additional layers, which are referred to as overlayers or intermediate layers. Typical film structures in that case are ABA or ABC where A and C are appropriate overlayers which may be the same or different.”

The statement indicates when the film has more than two layers, the additional layers may be overlayer or intermediate layers. And the examples given show three-layer structures, where B is the intermediate layer and A and C are the overlayers. But there is nowhere in the specification that A is indicated as an outermost layer as originally presented.

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 4 recites the amount of poly(m-xylenedipamide) to be 0-30% by weight in the base layer. Since claim 4 depends on claim 3, which recites the presence of poly(m-xylenedipamide) in the base layer, the compound cannot be 0% by weight in claim 4.

### ***Claim Objections***

5. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 11 repeats the same limitation of the polyester as recited in claim 1.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. In view of the prior Office action of 4/19/2005, the rejection of claims 1-5, 7-12, 14, and 16-21, under 35 U.S.C. 102(e) as being anticipated by Shelby et al. (US Pat. 6,562,276), has been withdrawn due to further consideration.

8. Claims 1-5, 7-12, 14, 16-17, 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (5,314,987).

Kim discloses a multilayer film for packages, the film comprising a first layer, a second layer, a third layer, and additional layers. The second layer (core layer) is disposed between the first and third layers with the additional layers on either or both sides of the first and third layers (see abstract; col. 7, ln. 4-10; col. 5, ln. 38-43). The second layer is formed from a blend comprising 92.5 wt % of PET and 7.5 wt % of MXD6 (see col. 7, Example 1). Kim further discloses the additional layers comprising a mixture of PET and MXD6 (see paragraph crossing col. 5 & col. 6). The film has an oxygen permeation of about 1.0 cc/mil/m<sup>2</sup>/day (see col. 7, ln. 59-63), which appears to read on the instantly claimed range.

In regards to the properties recited in claims 1, 12, 14, 17, and 19, since Kim teaches the same chemical composition of the multilayer film, the film of Kim's invention would inherently

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have the same properties, such as melt viscosity, gloss, interlaminar adhesion, orientation, and oxygen transmission, as those in the presently claimed invention.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim as applied to claim 1 above.

Kim is as set forth in claim 1 above and incorporated herein.

Kim does not teach the outermost layers disposed directly over the core layer. However, Kim teaches the first and the third layers comprise PET or PET copolyesters, which are the same polyesters in the core layer and the additional layers (see col. 5, ln. 21-26).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the first and the third layers would have included the poly(m-xylenedipamide) as the core and the additional layers, to enhance the gas barrier property of the multilayer film.

***Allowable Subject Matter***

11. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: no prior art has been found, whether alone or in combination, to teach, disclose, or fairly suggest a polyester film comprising a layer C disposed on layer B on the surface opposite layer A, wherein layer C alone comprises at least one anti-blocking agent; in combination with all of the other limitations in claims 20 and 21.

***Response to Arguments***

13. Applicant's arguments with respect to the rejection of the claims over Shelby et al. have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harada et al. (US Pat. 4,908,272) and Turner et al. (US Pat. 6,444,283) are cited of interest.

Harada discloses a gas-barrier multilayered structure for food containers, comprising at least one layer A of a copolyamide composed of a dicarboxylic acid component and a diamine component, and at least one layer B of a thermoplastic resin, such as PET. Both layers A and B

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further contain a second polyamide, such as poly(m-xylylene adipamide). (See abstract; col. 4, ln. 5-38, 64-67; col. 6, ln. 11-45).

Turner discloses a multilayered film for packaging, comprising at least one layer of PET and at least one layer of a blend of polyester/polyamide; wherein the polyester may contain repeat units of terephthalic acid, isophthalic acid, and ethylene glycol; and the polyamide may be poly(m-xylylene adipamide). (See abstract; col. 4, ln. 30-42; col. 6, ln. 53; col. 7, ln. 39-44).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt  
September 12, 2005

  
THAO T. TRAN  
PATENT EXAMINER